

REMARKS

Claim 76 is amended to define the invention with more clarity. No claims have been canceled. No new claims have been added. Applicant submits that all amendments are supported by the application-as-filed and that no new matter has been added. Claims 1-11, 23-30, and 65-79 are now in the application. Reconsideration of the application is respectfully requested in light of the foregoing amendments, the following remarks, and the enclosed DECLARATION under 37 CFR 1.131.

REJECTION UNDER 35 USC § 112, 2nd PARAGRAPH

Claim 76 stands rejected under 35 USC § 112, 2nd paragraph, as being indefinite. Applicant respectfully traverses the rejection. Nevertheless, in a good faith effort to move the case to allowance, Applicant herein amends Claim 76 so as to present the claim language with more clarity.

Amended Claim 76 now recites (in part):

a first said stud locator marking is separated from the leading edge of a second different said stud locator marking by a first distance,

whereby when a first stud is property mounted to said framing lumber product at said first stud locator marking and a second stud is property mounted to said framing lumber product at said second stud locator marking, said first and second studs define a second distance therebetween, and

the magnitude of the second distance is greater than the magnitude of the first distance so that at least a portion of each of said first and second stud locator markings remains visible while said first and second studs are mounted thereupon.

Applicant asserts that amended Claim 76 fully complies with the statutory definiteness requirements of 35 USC § 112, 2nd paragraph, as well as all other patentability requirements, and is otherwise in proper, allowable form. Accordingly, Applicant respectfully requests that the rejection be withdrawn and Claim 76 be allowed.

REJECTION UNDER 35 USC § 103

Claims 1-11, 23-30, and 65-79 stand rejected under 35 USC § 103 as unpatentable over Day (US 5,632,095) in view of Smyj (US 6,30,448). As will be explained in greater detail below, the rejection is rendered moot by the enclosed DECLARATION made under 37 CFR 1.131.

Nevertheless, as a *bona fide* attempt to fully respond to the Official Action dated 03/28/2005, and to advance the application as required by 37 CFR 1.111, Applicant respectfully traverses the rejection despite the inapplicability of the rejection in light of the enclosed DECLARATION.

Namely, Applicant asserts that the one can not arrive at the Claimed Invention by applying Day and Smyj. As one example, both Day and Smyj include a plethora of markings beyond any stud indicator markings. Actually, both Day and Smyj can be used,

by design, as measuring devices and correspondingly each includes many markings at regular, measuring-type, intervals, whereby neither Day nor Smyj, separate or combined, teach or suggest "substantially devoid of any location marking indicators away from the stud locator markings" as in Claim 7 and in other Claims. Rather, Day and Smyj expressly teach away from such.

Applicant also respectfully asserts that the proposed combination is improper and that there is no motivation, express or implied, to combine the adhesive tape of Smyj, which is to be "placed on a fixed base, typically a foundation or slab" (Col. 5, Lines 29-30), to the measuring device type lumber product of Day. Nevertheless, these issues and the rejections are mooted by the DECLARATION enclosed herewith.

DECLARATION OF PRIOR INVENTION under 37 CFR 1.131

With the enclosed DECLARATION, Applicant establishes invention of the subject matter of all rejected Claims prior to the effective date of the Smyj reference (May 19, 1999), by swearing behind the Smyj reference. Certain sections, including dates, of Exhibit #1 and Exhibit #2 (appended to the DECLARATION) have been blacked-out or deleted, as permitted (see MPEP Section 715.07). These blacked-out sections (including dates) contain proprietary or other information which is not needed for evaluation of this Declaration.

The showing of facts of the DECLARATION establish reduction to practice prior to May 19, 1999, and/or conception of the invention prior to May 19, 1999 and due diligence from prior to May 19, 1999 to a subsequent reduction to practice or filing of the Application.

In other words, each of the (blacked-out) dates in Exhibit #1 and Exhibit #2 is a date prior to May 19, 1999. Accordingly, Exhibit #1 shows constructive reduction to practice

and/or conception prior to May 19, 1999 and Exhibit #2 shows actual reduction to practice and/or conception prior to May 19, 1999.

Accordingly, Smyj (US 6,30,448) is not properly citable against the Claims, which renders the rejection moot, whereby Claims 1-11, 23-30, 65-75, 77-79, and amended Claim 76, are allowable over all properly citable references of record. Namely, by swearing behind Smyj reference, Applicant obviates the Examiner's basis for rejection, whereby the Claims are allowable. Applicant thus respectfully requests that the rejections be withdrawn, and that Claims 1-11, 23-30, 65-79 be allowed. In light of the above, a prompt Notice of Allowance would be greatly, and sincerely, appreciated by Applicant.

Applicant thus submits that all claims as presented herein are allowable over all references of record. Allowance is respectfully solicited. No fee is believed to be due. Should any fee be properly due, or if any refund is due, kindly charge same, or credit any overpayment, to Deposit Account 23-2130.

Respectfully submitted,
Fred Christian Baij

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By: 

Eric J. Lalor
Attorney for Applicant
(Reg. No. 54,631)

(Customer No. 23482)

Wilhelm Law Service
100 W. Lawrence St., 3rd Floor
Appleton, Wisconsin 54911
Telephone: 920-831-0100
Facsimile: 920-831-0101